

ESTTA Tracking number: **ESTTA465517**

Filing date: **04/04/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Gilda A. Solis
Granted to Date of previous extension	04/08/2012
Address	Calle San Pedro No. 9, Colonia La Joya, Tlalpan CP, Mexico DF, 14090 MEXICO

Name	Stillman de Mexico S. A. de C.V.
Granted to Date of previous extension	04/08/2012
Address	Calle San Pedro No. 9, Colonia La Joya, Tlalpan CP, Mexico DF, 14090 MEXICO
Party who filed Extension of time to oppose	Stillman de MÃ©xico S. A. de C.V. Stillman de MÃ©xico S. A. de C.V.
Relationship to party who filed Extension of time to oppose	ESTTA does not allow use of an accent above the letter "e" in the word Mexico.

Attorney information	EDOUARD V ROSA LAW OFFICES OF EDOUARD V ROSA 28047 DOROTHY DR, STE 305 AGOURA HILLS, CA 91301 UNITED STATES evrosalaw@att.net Phone:818-735-0590
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Applicant Information

Application No	85092438	Publication date	10/11/2011
Opposition Filing Date	04/04/2012	Opposition Period Ends	04/08/2012
International Registration No.	NONE	International Registration Date	NONE
Applicant	Shamim Akhter, partnership 143- East Street No. 18 Phase-I, Defence Housing Authority Karachi, PAKISTAN		

Goods/Services Affected by Opposition

Class 003.

All goods and services in the class are opposed, namely: BLEACHING PREPARATIONS AND OTHER SUBSTANCES FOR LAUNDRY USE, NAMELY, LAUNDRY DETERGENTS, CLEANING, POLISHING, SCOURING AND ABRASIVE PREPARATIONS, SOAPS, PERFUMERY, ESSENTIAL OILS, COSMETICS, HAIR LOTIONS, AND DENTIFRICES

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Breach of contract

Mark Cited by Opposer as Basis for Opposition

Attachments	Notice of Opposition.pdf (6 pages)(1123169 bytes) Exhibit 1.pdf (3 pages)(922280 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/edouardvrosa/
Name	EDOUARD V ROSA
Date	04/04/2012

In the matter of Trademark Application
Serial No. 85092438 for the mark: STILLMAN'S
Published in the Official Gazette on October 11, 2011

NOTICE OF OPPOSITION

Gilda A. Solis, (“Solis”), an individual having an address of Calle San Pedro No. 9, Colonia La Joya, Tlalpan CP, Mexico DF, 14090, Mexico and Stillman de México, S.A. de C.V. (“Stillman de Mexico”), a corporation organized under the laws of Mexico with its principal place of business at Calle San Pedro No. 0, Colonia La Joya, Tlalpan CP, Mexico DF, 14090 Mexico, (collectively referred to as “Joint Opposers”) believe that they will be damaged by the registration of the mark STILLMAN’S (“Applicant’s STILLMAN’S Mark”) as applied for in Application Serial No. 85092438 (the “Application”) by Applicant, Shamin Akhtar, a partnership DBA Shamin Akhtar organized under the laws of Pakistan comprising of Ms. Noor Jehan Begum, Citizen of Pakistan, S.M. Akhtar, citizen of Pakistan, S.M. Shahid, Citizen of Pakistan, and S.M.

Zahid, Citizen of Pakistan, with an address of 143-East Street No. 18, Phase-I, Defence Housing Authority, Karachi, Pakistan (“Applicant”) and hereby opposes the same for registration.

As grounds for the Opposition, Joint Opposers allege as follows:

1. Opposer Solis through her exclusive Licensee, Opposer Stillman de Mexico is now and has been for a number of years engaged in, among other things, the business of manufacturing, distributing, marketing and selling facial cream products under the Trademark Stillman’s (the “Stillman’s Trademark”).
2. Opposer Solis and/or her predecessor-in-interest The Stillman Company, Inc. (“The Stillman Company”) adopted and began using the Stillman’s Trademark at least as early as 1967 which is long prior to the filing date of Applicant’s Application. Opposer Solis’ Stillman’s Trademark has been used continuously used in the United States since that time, and through extensive sales, advertising and promotion Opposer Solis’ Stillman’s Trademark has come to represent substantial goodwill now owned by Opposer Solis. As a result, the public have come to attribute strong secondary meaning to the Stillman’s Trademark.
3. Opposer Solis’ predecessor-in-interest, The Stillman Company long prior to the filing date of Applicant’s STILLMAN’S Mark continuously and extensively used the trade name The Stillman Company in commerce in connection with the marketing and selling of facial cream products under the Stillman’s Trademark in the United States.
4. Opposer Stillman de Mexico long prior to the filing date of Applicant’s STILLMAN’S Mark continuously and extensively used the trade name Stillman de

Mexico in commerce in connection with the manufacturing, marketing and selling of facial cream products under the Stillman's Trademark in the United States.

5. On October 11, 2011, Applicant filed the Application under Section 44(e) of the Trademark Act. The goods listed in the Application as published in the Official Gazette on October 11, 2011, are "bleaching preparations and other substances for laundry use, namely, laundry detergents, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions and dentifrices" in International Class 3.

6. Joint Opposers obtained an extension of time to oppose the Applicant's Application until April 8, 2012.

7. On or about December 26, 1972, Opposer Solis' predecessor-in-interest The Stillman Company and Applicant entered into a written "Manufacturing-Sales Agreement Appointment of Agent" (the "1972 Agreement"). The 1972 Agreement enumerates, among other things, the manner(s) in which the parties can use the word mark Stillman's in connection with the manufacture and selling of freckle cream and bleach cream under the STILLMAN'S Mark which are products related to Opposer Solis' Stillman's Trademark for facial cream. A copy of the 1972 Agreement is attached hereto as Exhibit 1.

8. On October 12, 2010, Opposer Solis filed Application Serial No. 85150670 for "Stillman's" in International Class 003 for facial cream ("Opposer Solis' Application").

9. The Examining Attorney in an Office Action dated July 18, 2011, cited Applicant's Application as a potential bar to the registration of Opposer Solis' Application.

10. The Examining Attorney in a second Office Action dated July 18, 2011, issued a Suspension Notice which continued and maintained the potential bar to the registration of Opposer Solis' Application based on Applicant's prior filed Application.

11. Applicant's STILLMAN'S Mark so resembles Opposer Solis' prior common law rights in the Stillman's Trademark as to be likely when used on or in connection with Applicant's goods identified in the Application, to cause confusion, mistake or deception by causing the public to believe that the goods offered in association with Applicant's STILLMAN'S Mark emanate from Joint Opposers, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), with consequent damages to Joint Opposers and the public.

12. Applicant's STILLMAN'S Mark so resembles Joint Opposers' respective prior common law rights in The Stillman Company and Stillman de Mexico trade names as to be likely when used on or in connection with Applicant's goods identified in the Application, to cause confusion, mistake or deception by causing the public to believe that the goods offered in association with Applicant's STILLMAN'S Mark emanate from Joint Opposers, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), with consequent damages to Joint Opposers and the public.

13. Applicant's registration of the STILLMAN'S Mark will further interfere with Opposer Solis' registration of the Stillman's Trademark and the use of the Stillman's Trademark by Joint Opposers, and will seriously damage Joint Opposers.

14. Applicant's use and attempted registration of Applicant's STILLMAN'S Mark in the United States violates the terms of 1972 Agreement breaching Applicant's obligations thereunder. Pursuant to the 1972 Agreement, Applicant agreed among other things, "[t]hat STILLMAN agrees to appoint SHAMIN AKHTAR as its exclusive agent for Pakistan to manufacture and sell Stillman's Freckle Cream and Stillman's Bleach Cream in that country only...". 1972 Agreement, Paragraph 3. Further, the parties agreed "[t]hat this agreement is binding on all heirs and assigns of STILLMAN and SHAMIN AKHTAR"; "[t]his agreement shall be automatically renewed without further signing each year thereafter"; and "[t]his agreement may be cancelled by written notice by either party to the other for good cause or violation of this Agreement". 1972 Agreement, Paragraphs 9 and 10. Joint Opposers, on information and belief, are not aware of any cancellation of the 1972 Agreement by either Applicant or Opposer Solis. As such, Opposer Solis will be further damaged by the registration of Applicant's STILLMAN'S Mark because the registration will be in violation of Opposer Solis' contractual rights under the 1972 Agreement.

WHEREFORE, Joint Opposers respectfully request that this Opposition be sustained and that Applicant's Application Serial No. 85092438 be denied registration.

This Opposition and the applicable Filing Fee of \$600.00 (\$300.00 per each Opposer) are filed electronically with this document.

Respectfully submitted,

Dated: April 4, 2012



Edouard V. Rosa
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Attorney for Joint Opposers

CERTIFICATE OF TRANSMISSION AND SERVICE

I hereby certify that the foregoing NOTICE OF OPPOSITION is being electronically filed with the United States Patent and Trademark Office on April 4, 2012, and a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served on Harold L. Novick, Attorney of record for Applicant by mailing said copy on April 4, 2012, via First Class Mail, postage prepaid to:

Harold L. Novick, Esq.
H&A INTELLECTUAL PROPERTY LAW PLLC
2847 Duke Street
Alexandria, VA 22314

Date: April 4, 2012



Edouard V. Rosa

EXHIBIT 1

THE STILLMAN COMPANY, INC.

AURORA, ILLINOIS 60507 U. S. A.

CABLE ADDRESS "STILLCREAM"

CODES:
A. B. C.—5TH
BENTLEY IMPROVED
W. U. S. LETTER

MANUFACTURING - SALES AGREEMENT APPOINTMENT OF AGENT

It is hereby agreed between The Stillman Company, Inc., a corporation, doing business at 323 E. Galena Blvd., Aurora, Illinois, U.S.A. and M/S. Shamim Akhtar, doing business at 209, Marriot Road, Karachi, W. Pakistan:

1. That the above parties be hereinafter designated in this agreement as STILLMAN and SHAMIM AKHTAR.
2. That SHAMIM AKHTAR desires to manufacture and sell in Pakistan Stillman's Freckle Cream and Stillman's Bleach Cream, products produced and sold freely in the United States and many other parts of the world by STILLMAN.
3. That STILLMAN agrees to appoint SHAMIM AKHTAR as its exclusive agent for Pakistan to manufacture and sell Stillman's Freckle Cream and Stillman's Bleach Cream in that country only; and that STILLMAN agrees to supply formulas, manufacturing processes and sales knowledge to SHAMIM AKHTAR exclusively who may produce and sell Stillman's Freckle Cream and Stillman's Bleach Cream in Pakistan.
4. That SHAMIM AKHTAR agrees to purchase all materials necessary for the above production and observe all customary manufacturing caution, and proper labeling, to place Stillman's Freckle Cream and Stillman's Bleach Cream on the market in Pakistan.
5. It is hereby agreed that SHAMIM AKHTAR shall purchase ingredients for the manufacture of Stillman products from STILLMAN or other sources approved by them, either in semi-manufactured form or as raw materials and chemicals. Purchases made through STILLMAN shall be paid in American dollars.

THE STILLMAN COMPANY, INC.

AURORA, ILLINOIS 60507 U. S. A.

CABLE ADDRESS "STILLCREAM"

A. B. C. - 8TH
BENTLEY IMPROVED
W. U. S. LETTER

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6. That SHAMIM AKHTAR agrees not to manufacture or directly promote the sales of any article in direct competition to Stillman's Freckle Cream or Stillman's Bleach Cream.

7. That STILLMAN agrees not to sell, or invite sales of Stillman's Freckle Cream or Stillman's Bleach Cream directly in Pakistan, and also agrees to refer all inquiries to SHAMIM AKHTAR which STILLMAN receives from the above named country.

8. That SHAMIM AKHTAR agrees that all sales and manufacturing records for Stillman's Freckle Cream or Stillman's Bleach Cream be made available to STILLMAN or its designated officers or agents for inspection at any reasonable business hours.

9. That this agreement is binding on all heirs and assigns of STILLMAN and SHAMIM AKHTAR.

10. That this agreement shall be in effect from the date of last signing of both parties and shall continue for a period of one year thereafter. This agreement shall be automatically renewed without further signing each year thereafter. This agreement may be cancelled by written notice by either party to the other for good cause or violation of this agreement. A period of ninety (90) days shall thence elapse before this agreement shall become invalid. This agreement becomes valid upon the date of last signing of the principals below:

M/s. SHAMIM AKHTAR

By

S. S. Shamim Akhtar
Principal Title

Dated this 26th day of Dec 1972
in Karachi, W. Pakistan

THE STILLMAN COMPANY, Inc.

By

R. T. Stillman
Principal Title

Dated this 14th day of Dec 1972
in Aurora, Illinois, U.S.A.